

III. REMARKS

1. Claims 1 and 6 are amended.

2. With respect to the objection of claims 1, 2, 6 and 7, claims 1 and 6 are amended to include colons and semicolons for clarity. The amendments to the claims are not intended to be limiting, are not made for reasons related to patentability, and should not be interpreted to raise issues of estoppel.

3. Claims 1-9 are patentable over Heinonen et al. (US 6728530, hereinafter "Heinonen") and Elsey et al. (US 6775371, hereinafter "Elsey"). Claim 1 recites a second data storage including external data, the system further comprising i) a first communicator adapted to retrieve from said remote data repository data including, an object and/or information extracted from an object, ii) at least one predetermined criterion, defining a relationship between the retrieved data and said external data, iii) an analyzer, adapted to analyze whether said relationship fulfills a predetermined condition, and iv) a selector responsive to the analysis means, adapted to select data to be delivered to the mobile terminal when said condition is met.

As noted by the Examiner, Heinonen does not disclose or suggest the above noted features of Applicant's claim 1.

It is submitted that **Elsey is not prior art against Applicant's claimed invention** under 35 U.S.C. 103(a) as its filing date (i.e. 22 July 2002) is after the priority date of Applicant's application (i.e. 28 March 2002). The present Application is the National Stage of International Application No. PCT/FI02/00275 filed on 28 March 2002, designating the United States of America. A telephone call was placed to the Examiner in response to which the Examiner stated Elsey is valid because it is a continuation-in-part of US Patent 6,456,709 which has a filing date of 13 March 1997. Although Elsey is a continuation-in-part of US application number 09/520,306, which is a continuation-in-part of US patent 6,456,709 ("Cox") filed on 13 March 1997, Cox does not contain the subject matter relied upon by the Examiner in rejecting the claims. Therefore, the

portions of Elsey that the Examiner relies on are not entitled to a filing date earlier than 22 July 2002. Thus, Elsey cannot be used in the rejection of Applicant's claims. A further telephone call was placed to the Examiner's supervisor, George Eng, in an attempt to obtain a copy of US application number 09/520,306. The Examiner's supervisor stated that US application number 09/520,306, is an unpublished abandoned application that cannot be released to the public. Thus, Applicant's attempts to obtain the reference were unsuccessful. Thus, since the subject matter relied on by the Examiner is only found in Elsey, which has a filing date of 22 July 2002, after Applicant's filing date of 28 March 2002, Elsey is not prior art. Therefore, the rejection of Applicant's claims should be withdrawn for at least this reason.

Moreover, even if Elsey is a valid reference, combining Heinonen with Elsey does not remedy the above noted deficiency of Heinonen. Elsey does not disclose or suggest at least an analyzer, adapted to analyze whether said relationship fulfills a predetermined condition, and a selector responsive to the analysis means, adapted to select data to be delivered to the mobile terminal when said condition is met.

Elsey discloses directory assistance services for telephone users where the telephone users connect via standard telephone procedures to an assistant provider such as an operator. Elsey also discloses a pool of operators/agents, which the user connects to using standard telephone procedures for requesting concierge-like services. (See e.g. Abstract). The database server (136) and caller profile database server (134) at column 8, lines 12-22 of Elsey relied on by the Examiner in making the rejection are manually accessed by the operators. The operators look through the databases to provide information to the users or to connect the users to other parties via a telephone connection (See e.g. Col. 12, L. 9-17; Col. 12, L. 34-42; Col. 14, L. 60-66). All database searching and information from the searches is performed by and communicated to the user by human operators/agents via a traditional telephone call made by the user to the operator. Nowhere does Elsey disclose an analyzer, adapted to analyze whether said relationship fulfills a predetermined condition, and a selector responsive to the analysis

means, adapted to select data to be delivered to the mobile terminal when said condition is met as recited in Applicant's claim 1.

Thus, even if Elsey was proper prior art the combination of Heinonen and Elsey does not disclose or suggest all the features of Applicant's claim 1. Therefore, claim 1 is patentable. Claim 6 is patentable for reasons that are substantially similar to those described above with respect to claim 1. Claims 2-5 and 7-9 are patentable at least by reason of their respective dependencies.

Further, it is respectfully submitted that there is no legal motivation to combine Heinonen with Elsey. In order to establish a *prima facie* case of obviousness under 35 U.S.C. 103(a), there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. There must also be a reasonable expectation of success, and the reference(s), when combined, must teach or suggest all of the claim limitations. (See M.P.E.P. § 2142). As noted above, the combination of Heinonen and Elsey does not disclose or suggest each feature of Applicant's claims. Thus, a *prima facie* case of obviousness cannot be established.

Neither Heinonen nor Elsey provide any suggestion or motivation to be combined or modified as proposed by the Examiner and the Examiner's proposition that Applicant's invention would be obvious as recited in the claims is not supported by the factual contents of Heinonen or Elsey.

Heinonen is directed to a calendar display apparatus that displays the calendar information on a mobile terminal operable in a radio communication system (See Abstract).

Elsey on the other hand is directed to directory assistance services for telephone users where the telephone users connect via standard telephone procedures to an assistant

provider such as an operator (Abstract). In Elsey a user is required to place a telephone call to an operator. The operator then looks up directory information and/or the concierge serves desired by the user (See e.g. Col. 12, L. 9-17; Col. 12, L. 34-42; Col. 14, L. 60-66).

One skilled in the art would not be motivated to modify the calendar display apparatus of Heinonen with directory assistance services of Elsey as suggested by the Examiner because all information conveyed to the user in Elsey is conveyed via standard telephone procedures and between two people during a traditional telephone call placed by the user to the operator.

When "the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference". In re Rijckaert, 28 USPQ2d 1955, 1057 (Fed. Cir. 1993). The Examiner is requested to provide an indication as to where any such teaching, suggestion or motivation appears in the reference. Absent such a teaching, it is submitted that a *prima facie* case of obviousness over Heinonen and Elsey under 35 U.S.C. 103(a) is not established.

It is also submitted that Heinonen and Elsey have been combined improperly. References may be combined under 35 U.S.C. 103(a) only if the references are analogous art. In this case Elsey is not analogous art. A reference is analogous art if:

- 1) The reference is in the same field of endeavor as the applicant's; or
- 2) The reference is reasonably pertinent to the particular problem with which the applicant was concerned.

Elsey is not in the same field as the Applicant's. As described above, Elsey is directed to nothing more than directory assistance services for telephone users where the telephone users connect via standard telephone procedures to an assistant provider such as an operator (Abstract). In Elsey a user is required to place a telephone call to an operator.

The operator then looks up directory information and/or the concierge serves desired by the user (See e.g. Col. 12, L. 9-17; Col. 12, L. 34-42; Col. 14, L. 60-66).

This is clearly not the same field of endeavor as Applicant's. Elsey is simply not concerned with collected information that is downloaded through a network using a wireless link (without making a traditional telephone call) to be displayed to the user as called for in Applicant's claims.

Moreover, Elsey is not reasonably pertinent to the problem with which Applicant was concerned. Applicant was concerned with collected information that is downloaded through a network using a wireless link (without making a traditional telephone call) to be displayed to the user as called for in Applicant's claims.

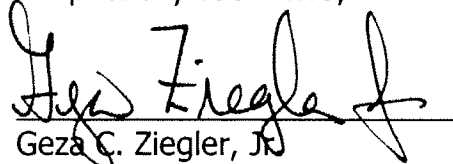
Again, Elsey is merely concerned with nothing more than directory assistance services that are accessed by making a traditional telephone call to an operator.

Since Elsey is not in the same field of endeavor and is not reasonably pertinent to the particular problem with which Applicant was concerned, Elsey is not analogous art. Therefore, Elsey may not be properly combined with Heinonen.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


Geza C. Ziegler, Jr.
Reg. No. 44,004

5 April 2007
Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800
Customer No.: 2512

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